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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,166	07/10/2003	Randall Eric Swanson	2295-004	4355
20575	7590	07/05/2007	EXAMINER	
MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			ZIRKER, DANIEL R	
ART UNIT		PAPER NUMBER		
1771				
MAIL DATE		DELIVERY MODE		
07/05/2007		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/618,166	SWANSON, RANDALL ERIC	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel Zirker	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 01 May 2007.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-5 and 18-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5, 18-32 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-5 and 18-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 18,19 and 22 of copending Application No. 10/728,647. Although the conflicting claims are not identical, they are not patentably distinct from each other because what minor modifications which may exist such as the character of the pretextured surface is believed to be a variable that is well within the ordinary skill of the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-5, 20, 24, 26-29, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by applicants' admissions in paragraph 7 of the first Brower Declaration, substantially for the reasons set forth in Paragraph No. 6 of Paper No. 20070307, together with additional observations concerning the recently filed Supplemental Brower Declaration executed April 30, 2007 and applicants' accompanying comments, along with the following additional observations. More particularly, the Brower Supplemental Declaration also fails to indicate **what was the earliest date that the claimed article(s) were first offered for sale, which is the moment that sets the 102(b) bar one year clock running, not the date on which the first actual sale was consummated**. Applicants' remarks in the Response (page 5) also totally overlook this crucial distinction. It is noted that in the aforementioned Paragraph 7 of the first Brower Declaration that Mr. Brower's company is stated to have

"began selling the Fast Patch" sometime in 1999, which if these were the only attempts to sell the product would not defeat those embodiments that were described in an enabling manner in the Dec 13, 1999 filed provisional application, since less than a year at most would have passed before the filing of the provisional application would stop the one year clock, but this has yet to be proven on the record. Consequently the Examiner must still hold that as to the above claims which comprise claim 1 and all of the claims which are dependent thereon, and also claim 20 which has substantially similar subject matter, the **prima facie** case of record has not been rebutted.

4. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Owens et al, substantially for the reasons set forth in paragraph No. 10 of Paper No. 033105. To reiterate, upon reconsideration the reference clearly discloses the claimed multilayer laminate in which a polypropylene sheet or layer, i.e. a flexible sheet having a substantially uniform thickness, (Col 3, lines 11-13) has on one outer surface a suitable layer of pressure sensitive adhesive and on the opposing outer surface the patch is ready to be painted with the same paint used on the wall section (Col 4, lines 20-24).

5. Claims 19, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al taken either individually or in view of either applicants' admissions in the specification at page 1, lines 25-28 and page 2, lines 3-4, or alternatively in view of Swallow, substantially for reasons previously of record such as set forth in Paragraph No. 13 of Paper No. 033105, together with the following additional observations. Owens et al is again relied upon substantially as previously set forth, teaching a variety of repair patches having an adhesive outer layer on one surface and a ready to paint

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opposing outer surface. With respect to such parameters as the presence of a textured outer surface note again that applicants admit in the specification that such elements as the presence of a textured coat and having the repair area painted to match the color of the surrounding area are well known in the art. Alternatively, note Swallow at Col 4, lines 40-42 for a teaching of a textured surface in a repair patch.

6. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al taken either individually, or in view of Estrada. Owens et al is again relied upon substantially as set forth, above, and note also that the reference further mentions (e.g. the Abstract, Col 1, lines 66-68) the presence of reinforcing materials such as applicants' contemplate. Alternatively, note that a suitable center reinforcement such as a rigid metal patch is clearly taught (see, e.g. the Figures) in Estrada, which is also clearly combinable art with the primary reference. Finally, whatever parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

7. Applicants' Terminal Disclaimer has overcome the prior double patenting rejection based upon the Swanson patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 - 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker  
Primary Examiner  
Art Unit 1771

